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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78884488
Applicant	Wheel Technology Ltd.
Applied for Mark	ROTO SHAVE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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In re Application of Wheel Technology Ltd. :  
Mark: ROTO SHAVE :  
Serial No. 78/884,488 :  
International Classes: 8 :  
----- x

**REPLY BRIEF OF APPLICANT**

Applicant respectfully submits this reply brief concerning the above-captioned mark.

**ARGUMENT**

As shown below, the Examining Attorney has declined to address the arguments actually raised by Applicant and thus has failed to carry his burden<sup>1</sup> of demonstrating a probability that consumers will be confused by the parties' marks.<sup>2</sup> As was also true during the course of prosecution, the Examining Attorney continues to ignore the possibility that a narrowing amendment would resolve this matter. From the perspective of an applicant, the frustrating effect is that a lack of meaningful communication prevents progress, raises costs and forecloses (until too late) practical solutions. Indeed, as shown in Applicant's opening brief, the Examining

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<sup>1</sup> *In re Calzaturificio Ennesport and Style S.N.C.*, No. 75/571,988, T.T.A.B. August 9, 2001 ("The Examining Attorney has the burden of proof to establish that the refusal to register is justified." *Id.* at 5, citing *In re 3Com Corp.*, 56 U.S.P.Q.2d 1060 (T.T.A.B. 2000)).

<sup>2</sup> *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1217, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility.")

Attorney at no time responded to the specific arguments put forth by Applicant and indeed did not articulate any specific, fact-based objections, until the November 20, 2007 Office Action rejecting Applicant's response to the Final Office Action. Even now, the Examining Attorney fails even to acknowledge Applicant's suggestion that a narrowing of its specification of goods might help resolve this matter.

The key errors of the Examining Attorney's arguments are as follows:

**First**, in stating the relevant test of confusion, the issue is not whether there is a likelihood (i.e. a probability) that "people" are likely to be confused; but whether there is a likelihood (i.e. a probability) that consumers are likely to be confused. The Lanham Act does not purport to remedy confusion generally, but only confusion among consumers.<sup>3</sup> It is thus essential to know who are the consumers of the products in issue and contrary to logic to refuse even to consider available evidence as to who are the relevant consumers. There is meaningful evidence in the record as to who are the consumers of the parties' products, but that evidence has simply been overlooked.

**Second**, overlooking the evidence of record as to the nature of the consumers of the Applicant's and the Registrant's products, the Examining attorney mistakenly characterizes as a collateral attack Applicant's mere citation of the record to clarify an ambiguous specification in the cited Registration. Indeed, Applicant's argument, which was perhaps insufficiently clear, is

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<sup>3</sup> Familiar precedent thus holds that "The Lanham Act seeks to prevent consumer confusion that enables a seller to pass off his goods as the goods of another." Lang v. Retirement Living Pub. Co., 949 F.2d 576, 582 (2d Cir. 1991) (quoting Programmed Tax Systems, Inc. v. Raytheon Co., 439 F. Supp. 1128, 1132 (S.D.N.Y. 1977) (quoting Jean Patou, Inc. v. Jacqueline Cochrane, Inc., 201 F. Supp. 861, 863 (S.D.N.Y. 1962), *aff'd*, 312 F.2d 125 (2d Cir. 1963))). "[T]he relevant confusion is that which affects the purchasing and selling of goods or services in question. ... [T]rademark law protects only against mistaken purchasing decisions and not against confusion generally." Lang, 949 F.2d at 583, (quoting Programmed Tax Systems, 439 F. Supp. at 1132).

not that the subject registration should now be limited in scope by a collateral attack, but that the specification in the subject registration is ambiguous, and needs to be understood in context. Just as any party searching the Principal Register to clear a mark would do if confronted with an ambiguous specification, Applicant has simply looked to the specimen of use that the Registrant itself submitted. The specimen makes clear what is meant by “razors for cutting hair” and further demonstrates the meaning and descriptive derivation of the term “roto” as well as the significant differences between the parties’ products.

**Third**, and similarly overlooking the nature of Applicant’s actual products, the Examining Attorney does not address Applicant’s arguments that it should have been permitted to offer a narrowing amendment during prosecution – or even now. As a result, all available evidence of the nature of the consumers of the parties’ products has been set aside, leading to a needlessly cabined assessment of the likelihood of confusion or not.

In failing even to acknowledge Applicant’s suggestion that it might narrow its specification of goods and in failing to consider the evidence of the actual meaning of the specification in the subject registration, the Examining Attorney instead simply “presumes” that Applicant’s shaving devices “are for cutting hair as in the Registrant’s specification” and, indeed, goes so far as to criticize Applicant because its “identification does not limit the razors to any specific type and razors are used for cutting hair.” (Brief at 4.) As shown by the promotional literature for Applicant’s ROTO SHAVE product submitted during prosecution and accompanying Applicant’s opening brief as Exhibit A, Applicant’s razors are used to shave ones face or legs, not for styling hair. They are fundamentally different from the Registrant’s goods even if the respective descriptions superficially suggest similarity. The Examining Attorney’s reliance on “presumptions” rather than evidence (and despite Applicant’s offer of a narrowing

amendment) well demonstrates why the refusal to register (or pass to publication) is in error and is not supported by the evidence.

**Fourth**, ignoring the obvious significance of the term “ROTO” (confirmed, *inter alia*, by the specimens accompanying the Registrant’s mark) as signifying rotational movement, the Examining Attorney’s arguments turn on an unsupported conclusion the element “roto” is arbitrary. In attempting to sustain his burden of proof, the Examining Attorney has not even addressed (much less rebutted) the evidence that *roto* literally means rotational (and would readily be understood as such by actual purchasers of Registrant’s products because the packaging for such goods prominently so-states). To the extent the Examining Attorney now purports to rely on free Internet dictionaries (unlike the same publishers’ more comprehensive subscription-only dictionaries) Applicant submits herewith a page from the far more authoritative Oxford English Dictionary confirming the descriptive character of the term “roto”.

Indeed, even without considering dictionary evidence, it is plainly evident from reviewing the Registrant’s specimen of use that the term “ROTO” as used in ROTORAZOR is descriptive of a razor that rotates. The specimen of use could not be more clear in stating, it is a “fully rotational styling razor.” Purchasers of such goods need no dictionary to read the product packaging and know that they are buying a rotating razor for hair styling. Even if the registration is entitled to a presumption of validity, as the Examining Attorney notes, that does not mean the mark is anything more than weakly suggestive and entitled to very limited scope. The Examining Attorney fails even to acknowledge Applicant’s argument. Similarly elevating above substance the mere administrative convenience of the International Classification system, the Examining Attorney ignores the undisputed evidence that there exist 262 pending applications and registrations for “roto” marks, instead concluding that the term “roto” is arbitrary simply

because only two of the 262 marks happen to be in Class 8. It is well settled that third party registrations are relevant to demonstrate the meaning of a term.

It is thus respectfully submitted that the Examining Attorney has misconstrued Applicant's arguments, which do not entail a collateral attack on the subject registration but, rather, an attempt to give contextual meaning to an ambiguous description, which is what all applicants must do when reviewing the Principal Register in clearing marks for use and registration; the Examining Attorney has failed even to consider the available evidence as to the meaning or strength of the Registrant's mark and the specific goods the parties' sell or the relevant markets to whom they sell such goods. Indeed, when the actual evidence is considered, it is apparent the parties' products are used on different types of hair, are used for different purposes and are purchased by different users. Because individuals can not readily style their own hair, and because the Registrant's goods are in fact sold only for professional use in hair salons, the trade channels are completely distinct – no more alike in their own way than are dentists' drills and toothbrushes. When such evidence is considered, as shown in Applicant's opening brief, there is no reason to conclude confusion is the probable result. If there are any doubts, the subject mark should be passed to publication to allow the Registrant to oppose.

Alternately, Applicant submits that the application should be remanded to allow the Applicant to submit a narrowing amendment to overcome the only specific objection voiced by the Examining Attorney during prosecution (namely, that “[t]he applicant's goods described as “non-electric razors” encompasses every type of non-electric razor used for any purpose, including the registrant's razors for cutting hair.”) Because that concern was raised only in response to Applicant's response the Final Office Action, Applicant has not had any opportunity to respond to this concern, and was unable to offer the possible limitation to the specification of

goods that its “non-electric razors” are “non-electric razors for use for shaving one’s face or body, not for styling hair” (or words to that effect).

### **CONCLUSION**

For the foregoing reasons, as well as those stated in its opening brief, Applicant submits that the Examining Attorney has not sustained his burden of proving a likelihood of confusion and that the mark ROTO SHAVE is thus entitled to registration on the Principal Register. Applicant thus respectfully requests that the refusal of the Examining Attorney to pass the subject application to publication be reversed or, alternatively, that the matter be remanded to the Examining Attorney for further consideration in light of the Applicant’s proposed amendment and limitation of its specification of goods.

Dated: New York, New York  
June 30, 2008

Respectfully submitted,

**WHITE & CASE LLP**

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ATTORNEYS FOR APPLICANT  
WHEEL TECHNOLOGY LTD.

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**roto-**

SECOND EDITION 1989

(*ˈrəʊtəʊ-*)

in some words also *rota-*, comb. form of L. *rāta* wheel, roller and Eng. ROTARY *a.*, ROTATION, etc., as in ROTOGRAPH, ROTOCHUTE, etc.

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